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| 09/990,670 | 11/16/2001 | Thomas Hicks | 6414-61471 | 2776 |
| 20575 | 7590 | 03/24/2006 | EXAMINER | |
| MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204 | | | TSOY, ELENA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1762 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/990,670 | Applicant(s) HICKS, THOMAS | |
| | Examiner Elena Tsoy | Art Unit 1762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-50, 52, 53 and 59-88 is/are pending in the application.
- 4a) Of the above claim(s) 38-39, 42-50, 52-53 and 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40, 41, 59-65 and 67-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Amendment filed on 3/06/2006 has been entered. Claims 4, 5, 22-26, 36, 51 and 54-58 have been cancelled. New claims 62-88 have been added. Claims 38-50, 52, 53, 59-88 are pending in the application. Claims 38-39, 42-50, 52-53, and 66 are withdrawn from consideration as directed to a non-elected invention.

Election/Restrictions

2. Newly submitted claim 66 is directed to silk-screen printing species, which is independent or distinct from the lithography printing species of claim 65.

Since applicant has received an action on the merits for the originally presented species of claim 65, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 66 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

3. Objection to claims 41, and 59-61 because of the informalities has been withdrawn due to amendment.

4. Objection to claims 57 and 58 because of the informalities has been withdrawn due to cancellation of the claims.

5. Objection to claim 60 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn due to amendment.

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6. Claims 40, 41, 78 and 87 are objected to because of the following informalities:

“opaciters” of claims 40, 78, 87 and “opacitors” of claim 41 should be spelled identically.

7. Claim 70 is objected to because of the following informalities: a phrase “the multiple different colored layers of ink are printed on top of each other using UV-cured lithographic printing press” should be changed “the UV-curable multiple different colored layers of ink are printed on top of each other using lithographic printing press”.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 40, 41, 59-65, and 67-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 40, 78 and 87 recite “*substantially smooth* and *uniform* outside multicolor coating” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed does not disclose that the surface of the multicolored image produced by **multiple** colored ink **layers** (clearly the produced multicolored image has certain surface irregularities of overlapped colored layers) should be considered to be *substantially smooth* and *uniform*. Nowhere the specification describes that

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other surfaces having irregularities greater than irregularities on the surface of the multicolored images should be considered NOT being *substantially smooth* and *uniform*.

Claims 40, 78 and 87 recite “applying sufficient opacifiers to the multiple different colored layers of ink or to the flexible plastic film” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed discloses the “opacifiers” only in connection with varnish: namely, the specification recites: “a flood matte **varnish topcoat** containing UV inhibitors, a hardening agent and **opacifiers** in an amount small enough to remain translucent” (See page 8, paragraph 4) and “one UV **varnish with opacifiers** added as a topcoat” (See page 8, paragraph 5). Therefore, the specification has *no support* for “applying sufficient opacifiers to the multiple different colored layers of ink or to the flexible plastic film”.

Claim 41 recites “wherein the opacifiers are included in either multiple different colored layers of ink or a **layer of hardening agents**, ... or a **UV protection layer**” which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed discloses the “opacifiers” only in connection with varnish: namely, the specification recites: “a flood matte **varnish topcoat** containing UV inhibitors, a hardening agent and **opacifiers** in an amount small enough to remain translucent” (See page 8, paragraph 4) and “one UV **varnish with opacifiers** added as a topcoat” (See page 8, paragraph 5). Therefore, the specification has *no support* even for the existence of “a **layer of hardening**

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agents” or “a UV protection layer”. Also the specification has *no support* for opaciters being included in multiple different colored layers of ink.

Claim 63 recites “**application of the opaciters** and the multiple different colored layers” which is not supported by the specification for the reasons discussed above.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Rejection of claims 40, 41, and 58-61 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

12. Claims 40, 41, 59-65, and 67-88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 40, 63, 78 and 88 recite “**applying** sufficient opaciters **to** the multiple different colored layers of ink or **to** the flexible plastic film” and “image formed by the printing of ink and the opaciters” which renders the claim indefinite because it is not clear whether opaciters are *added into ink* or *into* plastic film or opaciters themselves are applied on onto the surface of the ink layers or onto the surface of the plastic film. For examining purposes the phrase was interpreted according to the specification (See page 8) as “adding sufficient opaciters **into** colored ink or **into** the flexible plastic film”.

Claims 40, 78 and 87 recite “*substantially smooth* and *uniform* outside multicolor coating” which renders the claim indefinite because it is not clear at what degree of irregularities

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on the surface should be considered to be *substantially smooth* and *uniform*. According to claim language, the surface of a **multicolored image** produced by applying **multiple** colored ink **layers** (clearly the produced multicolored image has certain surface irregularities of overlapped colored layers) should be considered to be *substantially smooth* and *uniform*. If *irregular* surface of the **multicolored image** is *substantially smooth* and *uniform*, what kind of surface should be considered NOT being *substantially smooth* and *uniform*.

Claim 67 recites “the plastic film includes UV protection” which renders the claim indefinite because it is not clear whether the film itself includes UV protection or the film includes UV protection in its makeup. For examining purposes the phrase was interpreted according to description in the specification at page 7, first line of Preferred Embodiment as “the plastic film includes UV protection in its makeup”.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 40, 41, 60, 61, 63, 64, 67, 74, 75, 78-82, 87, 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager (US 3,815,263) in view of Holt (US 4,127,689), further in view of Bakker et al (US 5,959,067).

Oberwager in view of Holt are applied here for the same reasons as set forth in paragraph 10 of the Office Action mailed on 12/05/2005. One colored cut out section of plastic sheet in

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Oberwager in view of Holt is a single continuous non-laminated piece of thin, flexible plastic film material that includes a multicolored image of stained glass window and has *substantially* smooth and uniform outside surface on entire side of the plastic material, as required by new limitation because the claims do not recite that the film is sized to cover substantially an entire window.

Oberwager in view of Holt fail to teach that sufficient opacifiers are added **into** colored ink or **into** the flexible plastic film or to a clear matte finish (Claims 41).

Bakker et al teach that a composition can be made either transparent by using natural or synthetic transparent pigments, or *translucent* or opaque by using natural or synthetic opaque pigments: in *translucent* composition pigments are generally employed in amounts of up to about 6 weight % and in opaque composition pigments are generally employed in amounts of up to about 150 weight % (See column 5, lines 28-39).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added up to about 6 weight % of natural or synthetic opaque pigments either into plastic sheet or into ink or a clear matte finish in Oberwager in view of Holt with the expectation of providing the desired translucent sheet or ink since Bakker et al teach that a clear composition can be made *translucent* by adding to the composition natural or synthetic opaque pigments in amounts of up to about 6 weight %.

As to claims 74 and 75, Oberwager teaches that cling window covering can be made to simulate a stained glass window using assembled tiles (clearly by trimming) of translucent plastic of different colors.

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15. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Bakker et al, and further in view of Chmielnik.

Oberwager in view of Holt, further in view of Bakker et al are applied here for the same reasons as above. Oberwager in view of Holt, further in view of Bakker et al fails to teach that colors are provided by cyan, magenta and yellow inks.

Chmielnik teaches that the individual colors may be provided by inks in the primary colors of cyan, magenta and yellow.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used primary colors of cyan, magenta and yellow in inks of Oberwager in view of Holt, further in view of Bakker et al with the expectation of providing the desired color images, since Chmielnik teaches that the individual colors may be provided by inks in the primary colors of cyan, magenta and yellow.

16. Claims 62, 65, 68, 83-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Bakker et al, and further in view of Charley et al (US 6,030,002).

Oberwager in view of Holt, further in view of Bakker et al are applied here for the same reasons as above. Oberwager in view of Holt, further in view of Bakker et al fails to teach that a second translucent matte varnish is applied over a printed image (Claim 62); the inks are printed using lithographic printing process (Claims 65, 83).

Charley et al teach that a colored design 20 can be produced by lithographic offset printing process (See column 1, lines 21-35) to a clear or translucent cling vinyl film 16 (See column 2, lines 34, 45-55) of a film material 14, then covering with a very thin layer of

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translucent varnish 36 (claimed second matte finish) (See column 2, lines 23-24, 55-58), thereby forming a *translucent* cling decal for covering window (See column 4, lines 8-9). Charley et al further teach that inks are of Werneke Series (See column 3, lines 13-22), and the varnish is UV-curable varnish (See column 3, lines 20-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used lithographic offset printing process for applying clear or translucent inks, and applied a second matte varnish in Oberwager in view of Holt, further in view of Bakker et al since Charley et al teach that a colored design 20 can be produced by lithographic offset printing process to a clear or translucent cling vinyl film then covering with a very thin layer of *translucent* varnish thereby forming a *translucent* cling decal for covering window.

17. Claims 64 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Bakker et al, and further in view of Boden (US 3,562,941).

Oberwager in view of Holt, further in view of Bakker et al are applied here for the same reasons as above. Oberwager in view of Holt, further in view of Bakker et al fails to teach that the translucent vinyl sheet is made by applying a *translucent* matte finish to a top of a clear film material.

Boden teaches that instead of translucent plastic, a transparent plastic having a translucent coating (claimed matte finish) on its rear side can be used (See column 5, lines 73-75) for making daylight visual displays (See column 6, lines 43-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a clear film material having a *translucent* matte coating on its rear side

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instead of the translucent vinyl sheet of Oberwager in view of Holt, further in view of Bakker et al since Boden teaches that instead of translucent plastic, a transparent plastic having a translucent coating on its rear side can be used for making daylight visual displays.

Obviously, the same daylight visual effect would be achieved in Oberwager in view of Holt, further in view of Bakker et al, and further in view of Boden if clear film material 14 were having a *translucent* matte coating on its front side.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a clear film material having a *translucent* coating on its front side instead of the translucent cling vinyl sheet of Oberwager in view of Holt, further in view of Bakker et al, and further in view of Boden since obviously, the same daylight visual effect would be achieved if clear film material were having a *translucent* coating on its front side.

18. Claims 69-73, 76-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, in view of Bakker et al, further in view of Charley et al, and further in view of Taylor et al (US 5,672,413).

Oberwager in view of Holt, in view of Bakker et al, further in view of Charley et al are applied here for the same reasons as above. Oberwager in view of Holt, in view of Bakker et al, further in view of Charley et al fails to teach that the vinyl sheet has thickness in the range of 4-10 mils.

Taylor et al teach that polyvinyl chloride film about 50-150 microns thick (2-6 mils) commonly known as cling vinyl or static cling vinyl are flexible and can be used for carrying an image thereon to produce self-adhering stickers for automobile windows (self-adhering window covering), decals, etc. (See column 4, lines 27-31).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a translucent cling vinyl film 16 having thickness in the range of 2-6 mils in a film of Oberwager in view of Holt, in view of Bakker et al, further in view of Charley et al with the expectation of providing the desired self-adhering printed window covering since Taylor et al teach that cling vinyl or static cling vinyl having thickness of 2-6 mils can be used for carrying an image thereon to produce stickers for automobile windows (self-adhering window covering), decals, etc.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakazawa et al (US 4,457,961) teach that the addition of a required amount of pigment of transparent or semitransparent desired color tone to a transparent resin makes a resin layer transparent or translucent in the desired color tone (See column 2, lines 44-49).

Response to Arguments

20. Applicant's arguments with respect to rejected claims 40, 41, 59-65, 67-88 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

March 20, 2006

ELENA TSOY
PRIMARY EXAMINER
ETsoy